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| 10/623,212      | 07/18/2003  | Rickey D. Hart       | 022956-0233         | 2862             |

  

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| 21125                       | 7590 | 09/20/2007 |
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| EXAMINER         |  |
| PREBILIC, PAUL B |  |

  

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| ART UNIT | PAPER NUMBER |
| 3738     |              |

  

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|-------------------|---------------|
| NOTIFICATION DATE | DELIVERY MODE |
| 09/20/2007        | ELECTRONIC    |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket@nutter.com

## Office Action Summary

Application No.

10/623,212

Applicant(s)

HART, RICKEY D.

Examiner

Paul B. Prebilic

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 61-69, 71-89 and 95 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 72-74 and 84-89 is/are allowed.
- 6) ☒ Claim(s) 61-69, 71, 75-83 and 95 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 9/6/07.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 6, 2007 has been entered.

It is noted that the Applicant failed to fully respond to the previous Office action because the Applicant failed to point out where there was support for the claim amendments from the original specification; see the "Conclusions" section of the previous Office action. Failure to address this request in the future may result in the response being deemed non-responsive.

***Claim Objections***

Claims 67, 68, and 71 are objected to because of the following informalities:

With regard to claim 67, the language "screwed into said stepped bone hole" lacks antecedent basis from base claim 61.

With regard to claims 68 and 71, these claims have an identical scope even though the language is slightly different. Therefore, if base claim 61 were made allowable, one of these claims would have to be cancelled or amended so that the application could be allowed.

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 61-69, 71, 75-83, and 95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicholson et al (US 5,725,529) in view of Goble et al (US 4,870,957). Nicholson discloses a method of anchoring soft tissue within bone by inserting a stabilizing element (member (10) of Nicholson), threading a suture attached to soft tissue through an aperture of an insertion element (see Figures 5, 7, and 10 as well as column 8, line 47 et seq.), and then inserting the insertion element into the stabilizing element by deformably expanding it (see column 10, lines 29-67). However, Nicholson fails to teach threading the soft tissue through the aperture. Goble teaches that it was known to thread soft tissue (37) and a suture (stint (38)) together through an aperture in a similar anchor system; see the abstract and column 6, lines 26-38. Therefore, it is the Examiner's position that it would have been *prima facie* obvious to thread the soft tissue and suture together or the soft tissue only through the aperture of Nicholson (1) for the same reasons that Goble does the same or (2) to avoid an additional soft tissue-to-suture attachment step when one is not needed. This change would shorten and simplify the procedure.

With regard to claims 63 and 66, the Applicant is directed to see Figure 3.

With regard to claim 65, the Applicant is directed to see column 7, line 46 et seq.

With regard to claim 69, Goble teaches that utilizing a second anchoring system was known when an ACL replacement is performed. It is the Examiner's position that it would have been obvious to an ordinary artisan to attach the other end of the Nicholson tendon or soft tissue to bone in the same manner when repairing an ACL injury.

***Allowable Subject Matter***

Claims 72-74 and 84-89 are allowed over the prior art of record.

***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Paul Prebilic/  
Paul Prebilic  
Primary Examiner  
Art Unit 3738